

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 20 and 29, claims 18, 19, 21 to 28, and 30 to 35 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the acknowledgment that all certified copies of the priority documents have been received.

II. Objection to Claim 33

Regarding the objection to claim 33, the Examiner will note that claim 33 has been amended herein without prejudice to delete “27” from the claim, thereby obviating the present objection. Withdrawal of this objection is therefore respectfully requested.

III. Rejection of Claims 18, 25, 26, and 27 Under 35 U.S.C. § 102(b)

Claims 18, 25, 26, and 27 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,667,898 (“Anderson et al.”). It is respectfully submitted that Anderson et al. does not anticipate the present claims for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In other words, to be anticipatory, a single prior art reference must show all of the limitations of the claims arranged or combined in the same way as recited in the claims. Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008).

Claim 18 relates to a run-in coating for a gas turbine, including, *inter alia*, the features that *the run-in coating is less porous at a region facing a housing than at a region facing rotor blades*. Claims 26 and 27 include features analogous to those included in claim 18.

Anderson et al. does not disclose, or even suggest, all of the features included in claims 18, 26, and 27. Anderson et al. merely indicates a ceramic body including aluminum titanate. Col. 6, lines 33 to 37. However, nowhere does Anderson et al. disclose that the ceramic body is less porous at a region facing a housing than at a region facing rotor blades. Therefore, Anderson et al. does not disclose, or even suggest, the feature that *a run-in coating is less porous at a region facing a housing than at a region facing rotor blades*.

Accordingly, Anderson et al. does not disclose, or even suggest, all of the features included in claims 18, 26, and 27. As such, it is respectfully submitted that Anderson et al. does not anticipate claims 18, 26, and 27.

As for claim 25, which ultimately depends from claim 18 and therefore includes all of the features included in claim 18, it is respectfully submitted that Anderson et al. does not anticipate this dependent claim for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 19, 20, 22, 28, and 29 Under 35 U.S.C. § 103(a)

Claims 19, 20, 22, 28, and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Anderson et al. and U.S. Patent No. 6,982,126. Claims 20 and 29 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 20 and 29. It is respectfully submitted that the combination of Anderson et al. and U.S. Patent No. 6,982,126 does not render unpatentable the presently pending claims for at least the following reasons.

U.S. Patent No. 6,982,126 does not constitute prior art against the present application. In this regard, U.S. Patent No. 6,982,126 issued on **January 3, 2006** and is stated on its face to have a filing date of **November 26, 2003**. The present application is the national stage of PCT/DE04/01683, having an international filing date of **July 28, 2004** and claims priority to German Application No. DE 103 37

094.3, filed on **August 12, 2003**. A claim of priority was made, *inter alia*, in the Declaration and Power of Attorney, and the Office has acknowledged receipt of the certified copies of the priority documents. A certified English-language translation of German Application No. DE 103 37 094.3 is submitted herewith. As such, U.S. Patent No. 6,982,126 does not constitute prior art against the present application. Withdrawal of this rejection is therefore respectfully requested.

V. Rejection of Claims 24 and 30 Under 35 U.S.C. § 103(a)

Claims 24 and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Anderson et al. and that which the Office characterized as Applicant Admitted Prior Art ("AAPA"). It is respectfully submitted that the combination of Anderson et al. and AAPA does not render unpatentable the present claims for at least the following reasons.

Claim 24 depends from claim 18, and claim 30 depends from claim 27. As more fully set forth above, Anderson et al. does not disclose, or even suggest, all of the features included in claims 18 and 27. The AAPA also does not disclose, or even suggest, all of the features included in claims 18 and 27, and thus, fails to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Anderson et al. and AAPA does not disclose, or even suggest, all of the features included in claims 18 and 27, from which claims 24 and 30 depend. As such, it is respectfully submitted that the combination of Anderson et al. and AAPA does not render unpatentable claims 24 and 30, which depend from claims 18 and 27.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Allowable Subject Matter

Applicants note with appreciate the indication of allowable subject matter included in claims 21, 23, and 31 to 35.

Claims 21, 23, 31, and 34 have been amended herein without prejudice to include all of the limitations of their base claims and any intervening claims. As such, it is respectfully submitted that claims 21, 23, 31, and 34, as well as dependent claims 32, 33, and 35, are in condition for immediate allowance.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: October 16, 2009

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646